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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,358	11/21/2003	Mohammad R. Marzabadi	65369-BA/JPW/ANX	2152
7278	7590	01/14/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/719,358	MARZABADI ET AL.
Examiner	Art Unit	
Celia Chang	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 October 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10-18,28-33,55,62,63 and 68-70 is/are pending in the application.  
 4a) Of the above claim(s) 10-18 and 62 is/are withdrawn from consideration.  
 5) Claim(s) 28-33 is/are allowed.  
 6) Claim(s) 55 is/are rejected.  
 7) Claim(s) 63 and 68-70 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election with traverse of group IV claims 28-33 in the reply filed on Oct. 4, 2004 is acknowledged. The traversal is on the ground that all compounds has the 4-phenylpiperidinyl core, thus, does not warrant "burden" of search. This is not found persuasive because it was clearly delineated that the diversified class and subclasses that accompany each group which are not co-extensive, especially, the R1 group must be considered structurally being the core since when R1 differ, the utility differ as evidenced by CA 136:96697 and CA 136:325564 of record. Please note that proper core must be an "art recognized" class or core, see In re Ruff 118 USPQ 340. The instant grouping of restriction was based upon art recognized core structure being separate classes. Applicants merely alleged "no burden" without any rational as to why the diversified groups can be searched together.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-9, 34-54, 56-61, 64-67, 71-79 have been canceled. Claims 28-33 are examined. Claims 55, 63, 68-70 are prosecuted together with the elected compounds to the extend of claim 28. Claims 10-18, 62 and the remaining subject matter of claims 55, 63, 68-70 are withdrawn from consideration per 37 CFR 1.142(b).

2. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is confusing as to what "therapeutically amount" is. Please use "therapeutically effective amount".

3. Claims 63, 68-70 are objected to because they are dependent on the non-elected claims. Amendment to single dependency on claim 28 is recommended.

4. Claims 28-33 are allowed.

Claims 28-33 compounds are neither anticipated nor rendered obvious by the art of record. The closest prior art compounds are found in WO 02/081460 wherein the linker between the indolyl moiety and the piperidinyl ring is a multiple element chain (see p.47 compound No. 94) and no suggestion for modification to the instant single methylene linker was found.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
Jan. 11, 2005

  
Celia Chang  
Primary Examiner  
Art Unit 1625